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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE A. ROGERS and DAVID LIVINGSTON

Appeal 2009-008529
Application 10/764,237
Technology Center 3700

Before LINDA E. HORNER, STEVEN D.A. MCCARTHY, and
KEN B. BARRETT, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Bruce A. Rogers and David Livingston (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1, 3-7, and 11-15. Claim 2 has been canceled, and claims 8-10 have been withdrawn from consideration. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM-IN-PART.

THE INVENTION

Appellants' claimed invention is a hair holding device. Spec. 1. Claim 1, reproduced below, is the sole independent claim and is representative of the subject matter on appeal.

1. A hair holding device comprising:

a first body member and a second body member, said first and second body members comprising hair gripping portions adapted to be squeezed by a user whereby said hair gripping portions come into contact with gathered strands of a user's hair;

hinge means for pivotally connecting said first and second body members; and

adjustment means comprising a slip friction mechanism coaxially arranged with respect to said hinge means for causing said hair gripping portions to remain at a point at which said hair gripping portions are squeezed together by a user.

THE EVIDENCE

The Examiner relies upon the following evidence:

Wilde	US 870,830	Nov. 5, 1907
Sheehan	US 3,546,750	Dec. 15, 1970
Rizzuto	WO 02/058504 A1	Aug. 1, 2002

THE REJECTIONS

Appellants seek review of the following Examiner's rejections:

1. Claims 1 and 3-7 are rejected under 35 U.S.C. § 102(b) as being anticipated by Wilde.
2. Claims 1, 3-7, and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sheehan.
3. Claims 1, 3, and 12-15 are rejected under 35 U.S.C. § 102(e) as being anticipated by Rizzuto.

ISSUES

The issues presented by this appeal are:

Are Wilde's inwardly-convex, dished circular clamping ends 7 and 11 structurally distinguishable from the "hair gripping portions [which] come into contact with gathered strands of a user's hair" as called for in claim 1?

Does Sheehan's one-way gripping mechanism anticipate the claimed slip friction mechanism as called for in claim 1?

Does Rizzuto disclose an "adjustment means comprising a slip friction mechanism" as called for in claim 1?

ANALYSIS

Claim Construction

We begin our analysis by determining whether “adjustment means comprising a slip friction mechanism coaxially arranged with respect to said hinge means for causing said hair gripping portions to remain at a point at which said hair gripping portions are squeezed together by a user” as called for in claim 1 invokes interpretation under 35 U.S.C. § 112, sixth paragraph.

The “adjustment means” claim element uses the phrase “means ... for.” Further, the “adjustment means” claim element is modified by the functional language of “causing said hair gripping portions to remain at a point at which said hair gripping portions are squeezed together by a user.” As such, a presumption inures that the “adjustment means” limitation invokes § 112, sixth paragraph.

That presumption is overcome in this instance, however, because the “adjustment means” limitation further recites sufficient structure within the claim to perform entirely the recited function. *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427-28 (Fed. Cir. 1997) (“[W]here a claim recites a function, but then goes on to elaborate sufficient structure, material, or acts within the claim itself to perform entirely the recited function, the claim is not in means-plus-function format” even if the claim uses the term “means.”). In particular, the “adjustment means” claim limitation further calls for “a slip friction mechanism coaxially arranged with respect to said hinge means.”

Appellants' Specification defines "slip friction mechanism" as follows:

As used herein, the term "slip friction mechanism" shall mean an assembly which is derivative of a ratchet and a slip friction disk clutch assembly. It is derivative of a ratchet in that it is used to progressively tighten the hair gripping portions 122, 124 about a lock or shock of hair as described below. And, it is derivative of a slip friction disk clutch assembly in that the position into which the wearer squeezes the hair gripping portions 122, 124 may be overcome by a rotational force which exceeds the friction force of adjustment mechanism 136, similar to the manner in which a friction clutch slips when the torque applied to the clutch is too great (although, unlike a friction clutch, the various slip friction mechanisms described herein are passive in nature, i.e., they do not serve to drive any parts of the hair holding device). The slip friction mechanisms of the present invention comprise a first surface associated with a first body member (e.g., body member 112), a second surface associated with a second member (e.g., second body member 114), and biasing means for maintaining contact between the first and second surfaces whereby a slip friction interface is created between the first and second surfaces. The shear or friction force generated at the slip friction interface must be sufficient in all instances (regardless of whether a torsion spring or other body member biasing means is present) to cause the body members to remain in the desired hair holding position selected by the user until such time that the user chooses to doff the device by applying a rotational opening force that exceeds the friction or shear force at the slip friction interface.

Spec. 9, l. 10 – 10, l. 2. Thus, the Specification discloses the claimed "slip friction mechanism" is an assembly having a first surface associated with a first body member (e.g., body member 112), a second surface associated with a second member (e.g., second body member 114), and biasing means

for maintaining contact between the first and second surfaces whereby a slip friction interface is created between the first and second surfaces, and which is used to progressively tighten the hair gripping portions about hair and whereby the position into which the wearer squeezes the hair gripping portions may be overcome by a rotational force which exceeds the friction force of the adjustment mechanism. As such, the claim recites sufficient structure in the “slip friction mechanism” to perform entirely the recited function of causing the hair gripping portions to remain at a point to which they are squeezed together such that the adjustment means claim limitation does not invoke § 112, sixth paragraph.

We now turn to the claimed “hair gripping portions” and interpret this claimed structure in view of Appellants’ Specification. Appellants’ Specification does not provide a definition of “hair gripping portions.” Appellants’ Specification describes, with reference to Figures 2-5, that the invention includes “hair gripping portions 122 and 124 which terminate in a plurality of interdigitated hair-engaging fingers or tines 126 and 128.” Spec. 8, ll. 18-20. Appellants’ Specification similarly describes, with reference to Figures 6-8, that the invention includes “hair gripping portions 222 and 224 which terminate in a plurality of interdigitated hair-engaging fingers or tines 226 and 228.” Spec. 13, ll. 32-34. For each embodiment, the figures show the hair gripping portions as opposing concave surfaces that terminate in interdigitated tines. Spec., figs. 2 and 6.

Claim 1, however, does not call for the hair gripping portions to be concave or to terminate in interdigitated fingers or tines, nor does the claim

call for the hair gripping portions to be capable of gripping “a lock or shock of hair” as argued by Appellants. Br. 4. Rather, claim 1 recites “hair gripping portions adapted to be squeezed by a user whereby said hair gripping portions come into contact with gathered strands of a user’s hair.” As such, claim 1 requires only that the hair gripping portions are capable of gripping at least two gathered strands of a user’s hair.

Rejection of claims 1 and 3-7 under 35 U.S.C. § 102(b) as being anticipated by Wilde

Appellants argue claims 1 and 3-7 as a group for this ground of rejection. Br. 4-5. As such, we select claim 1 as representative, and claims 3-7 stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner found that Wilde discloses a first body member (a) including a gripping portion 7 and a second body member (at 12) including a gripping portion 11, and that the gripping portions are adapted to be squeezed by a user. Ans. 3. The Examiner further found that these gripping portions 7 and 11 are capable to hold the hair of the user. Ans. 6. We agree with these findings of the Examiner and adopt them as our own.

Appellants “initially note ... that the Wilde device is an ear ring. It is not a hair holding device.” Br. 4. While we acknowledge that Wilde’s structure is intended to be used as an ear ring, the Examiner has taken the position that Wilde’s structure is also capable of use as the claimed hair holding device and does not differ structurally from the claimed hair holding device. Ans. 5-6 (noting that the phrase “hair holding” is a recitation of intended use, and finding that Wilde discloses all the claimed structures and

that its clamping surfaces are capable to hold the hair of the user.) “It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citations omitted).

Appellants argue that Wilde does not disclose the claimed hair gripping portions, because if the clamping surfaces of the ear ring of Wilde were used to clamp a wearer’s hair, “they would clamp little more than a few strands of hair at the centralmost portions of the clamping surfaces.” Br. 5. Yet, based on our claim interpretation of “hair gripping portions” *supra*, all that is required by claim 1 is that the hair gripping portions are capable of gripping at least two gathered strands of a user’s hair. Appellants chose to define the hair gripping portions functionally instead of structurally. In particular, claim 1 defines the hair gripping portions by the function they perform, that of coming into contact with gathered strands of a user’s hair when squeezed by a user.

A patent applicant is free to recite features of an apparatus either structurally or functionally. *See In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971) (“[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. *In re Schreiber*, 128 F.3d at 1478. As stated in *Swinehart*, 439 F.2d at 213:

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent

characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

See also In re Best, 562 F.2d 1252, 1254-55 (CCPA 1977) and *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (“when the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.”).

Appellants have failed to provide adequate evidence or argument to show that Wilde’s clamping surfaces 7, 11 would not inherently possess the characteristic to grip and come into contact with gathered strands of a user’s hair when the clamping surfaces are squeezed together by a user. As such, we will sustain the Examiner’s rejection of claim 1. Claims 3-7 fall with claim 1.

Rejection of claims 1, 3-7, and 11 under 35 U.S.C. § 102(b) as being anticipated by Sheehan

The Examiner found that Sheehan discloses all the elements of claim 1 including a slip friction mechanism having an irregular first surface 32 associated with the first body member, an irregular second surface 35 associated with the second body member, and a biasing mechanism 38 for maintaining contact between the first and second surfaces. Ans. 4.

Appellants argue that Sheehan does not disclose a slip friction mechanism because the Sheehan device uses a one-way ratchet mechanism that prevents reverse rotation of the arms. Br. 8.

Sheehan discloses a fastener or cable tie for holding together a bundle of materials, such as strands, cables, wires and the like. Sheehan, col. 1, ll.

48-52. Sheehan discloses that in its fastener “the set of ratchet teeth of one head lock[] the set of ratchet teeth in the other head to prevent reversed relative rotation of said heads and arm members.” Sheehan, col. 1, ll. 24-27. In other words, one head member and its associated curved arm are rotatable about the other head member and its associated arm “in one direction only, as the meshing sets of ratchet teeth 32, 35 afford but one direction of relative rotation of head members 26, 28.” Sheehan, col. 3, ll. 3-7; *see also id.* at col. 3, ll. 49-51. To release the bundle, the arms may be severed. Sheehan, col. 3, ll. 15-19.

As noted *supra* in our claim construction, Appellants’ Specification defines the “slip friction mechanism” as being derivative of a ratchet and a slip friction disk clutch assembly and that is used to progressively tighten the hair gripping portions 122, 124 about hair and whereby the position into which the wearer squeezes the hair gripping portions 122, 124 may be overcome by a rotational force which exceeds the friction force of adjustment mechanism 136. Spec. 9, l. 10 – 10, l. 2. As such, the claimed “slip friction mechanism” requires that the friction force of the adjustment mechanism may be overcome by a reverse rotational force, and thus it does not encompass a one-way ratchet mechanism, such as disclosed in Sheehan. Hence, we will not sustain the Examiner’s rejection of claims 1, 3-7, and 11 under 35 U.S.C. § 102(b) as being anticipated by Sheehan.

Rejection of claims 1, 3, and 12-15 under 35 U.S.C. § 102(b) as being anticipated by Rizzuto

The Examiner found that Rizzuto discloses each and every element of claim 1 including a slip friction mechanism having a first surface 23 associated with the first body member, a second surface 25 associated with the second body member, and a torsion spring 26 for maintaining contact between the first and second surfaces. Ans. 5.

Appellants argue that “Rizzuto contains no disclosure of adjustment means comprising a ‘slip friction mechanism’ as described in Appellants’ specification and as recited in Appellants’ claim 1.” Br. 10.

Rizzuto discloses “a clip positioned by a hinge and spring means which remain wholly hidden from view when the ornament is borne in the hair, and which can be firmly clamped in the hair.” Rizzuto 1, para. [0002]. In particular, Rizzuto discloses a clip having elongated limbs 12 and 14, having respective abutting sliding planes 23 and 25. Rizzuto 2-3, para. [0014]. A spring 26 biases the limbs 12 and 14 in the closed position. Rizzuto 3, para. [0017].

We agree with Appellants that Rizzuto discloses a conventional spring-biased hair clip but for a concealed spring assembly. Br. 10. As noted *supra* in our claim construction, Appellants’ Specification defines the “slip friction mechanism” as being derivative of a ratchet and a slip friction disk clutch assembly that is used to progressively tighten the hair gripping portions 122, 124 about hair and whereby the position into which the wearer squeezes the hair gripping portions 122, 124 may be overcome by a

rotational force which exceeds the friction force of adjustment mechanism 136. Spec. 9, l. 10 – 10, l. 2. Rizzuto's sliding planes 23 and 25 do not appear to function as a ratchet mechanism. As such, Rizzuto does not disclose the claimed slip friction mechanism. Hence, we will not sustain the Examiner's rejection of claims 1, 3, and 12-15 under 35 U.S.C. § 102(b) as being anticipated by Rizzuto.

Evidence of Secondary Considerations

Because we are sustaining the Examiner's rejection of claims 1 and 3-7 under 35 U.S.C. § 102(b) as being anticipated by Wilde, we feel the need to briefly address the Appellants' proffered evidence of secondary considerations of non-obviousness. *See* Br. 11-15 (arguing that the previously-submitted Declarations of Ms. Rommy Revson and Ms. Mary Lafauci demonstrate objective evidence of long-felt need). We address this submitted evidence only to note that the current rejections before us on appeal are not based on obviousness under 35 U.S.C. § 103. Rather, all three rejections on appeal are based on anticipation under 35 U.S.C. § 102(b). As such, we fail to see the relevance of this objective evidence of non-obviousness to our review of the anticipation rejections before us. *See In re Wiggins*, 488 F.2d 538, 543 (CCPA 1973) (stating that evidence of commercial success, unexpected results, etc. is not pertinent to a rejection made under § 102(b), and that such evidence "no matter how striking could not overcome a rejection of a claim based on its lack of novelty. It simply is not relevant or material to that point.").

CONCLUSIONS

Wilde's inwardly-convex, dished circular clamping ends 7 and 11 are not structurally distinguishable from the "hair gripping portions [which] come into contact with gathered stands of a user's hair" as called for in claim 1.

Sheehan's one-way gripping mechanism does not anticipate the claimed slip friction mechanism as called for in claim 1.

Rizzuto does not disclose an "adjustment means comprising a slip friction mechanism" as called for in claim 1.

DECISION

The decision of the Examiner to reject claims 1 and 3-7 is
AFFIRMED. The decision of the Examiner to reject claims 11-15 is
REVERSED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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